

## **REMARKS**

Reconsideration of the present application, as amended, is respectfully requested. Claim 41 has been amended.

### **1. Summary of the Office Action**

Examiner rejected claims 1-3, 6, 9-11, 19-22, 26, 31, and 37-40 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2002/0171737 to Tullis in view of U.S. Patent No. 6,606,669 to Nakagiri and further in view of U.S. Patent No. 6,353,848 to Morris.

Examiner rejected claims 4, 12, and 17-18 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 1 above, and further in view of U.S. Patent No. 6,628,325 to Steinberg et al.

Examiner rejected claims 7-8 and 16 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 1 above, and further in view of U.S. Patent Publication No. 2003/0142215 to Ward et al.

Examiner rejected claims 13-15 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris and further in view of Steinberg as applied to claim 12 above, and further in view of U.S. Patent No. 5,737,491 to Allen et al.

Examiner rejected claims 23-25, 29-30, and 32 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 21 above, and further in view of Steinberg.

Examiner rejected claims 27-28 and 36 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 21 above, and further in view of Ward.

Examiner rejected claims 33-35 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 21 above, and further in view of Allen.

Examiner rejected claims 41, 43-45, 51, 59, and 62 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,613 to Endsley et al. in view of Nakagiri, further in view of Morris.

Examiner rejected claims 42, 49-50, 52, and 57-58 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of Steinberg.

Examiner rejected claim 46 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of U.S. Patent No. 6,535,243 to Tullis et al.

Examiner rejected claims 47-48, 56, and 61 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of Ward.

Examiner rejected claims 53-55 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of Steinberg and further in view of Allen.

Examiner rejected claim 60 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of U.S. Patent No. 6,529,969 to Inoue.

**2. Response to 35 U.S.C. §103(a) rejections**

Regarding Tullis/Nakagiri/Morris combination, Applicants respectfully submit that there is no suggestion within the references themselves for the combination suggested by Examiner. As it was submitted in response to the Office Action mailed on August 2, 2004, Tullis specifically teaches away from “establishing a communication session supporting photo-serving communication protocols that present the digital camera device as a file server to the host device,” by stating that “the camera can display previously captured images by accessing image data that is stored in the host computer. For example, the hand-held digital camera can access and display an image that was captured the previous day, since the data is stored in the host computer. (Tullis, paragraph 11, emphasis added). Thus, since the data is stored in the host computer in the system of Tullis, the camera device need not act as a file server, since there is no data for it to serve.

Since Tullis specifically teaches away from such a combination, by providing a camera device that does not store its own data, thus ensuring that the camera need not act as a file server, there is no motivation to include the use of a host server of Morris into Tullis. Therefore, Applicants respectfully submit that the combination is improper, and the claims cannot be rejected over Tullis in combination with Nakagiri and Morris. Applicants therefore respectfully request the withdrawal of this rejection.

Furthermore, even in combination, Tullis, Nakagiri, and Morris do not make the present invention obvious. Claim 1 recites in part “the digital camera device ... **based on said determined communication information**, establishing a communication session between the digital camera device and the particular host device, said communication session supporting photo-serving communication protocols that present the digital camera device as a file server to the host device.” Examiner submits that Tullis discloses “...the method comprising: based on said determined communication information.” Examiner references paragraph 9 on page 1 of Tullis, where a method to allow a digital camera to have continuous access to large volumes of digital image data utilizing a bi-directional wireless communications link between a host computer and the camera is described. Tullis discloses the bi-directional wireless communications link between the hand-held digital camera and the host computer that can transfer data at a sufficiently high rate to provide virtually real-time feedback to a camera operator.

The phrase “based on said determined communication information” makes no sense in the context of the cited passage for at least the reason that there is no mention of determining communication information. Furthermore, the phrase “based on said determined communication information” is meaningless unless it is used in a context, such as, for example, “based on said determined communication information, establishing a communication session between the digital camera device and the particular host device.” As noted by Examiner, Tullis, in view of Nakagiri, fails to disclose or suggest “establishing a communication session between the digital camera device and the particular host device,” Therefore, inherently, Tullis, in view of Nakagiri, also fails to disclose **based on said determined communication information**,

establishing a communication session between the digital camera device and the particular host device,” as recited in claim 1.

Examiner submits that this limitation is disclosed in Morris and cites the following passage in Morris:

... the present invention provides a method for *making a digital camera and its internally stored data remotely accessible*. The present invention enables the digital camera to be set to continuously take pictures of scenes and items of interest and to allow a user to access those pictures at any time. The present invention implements remote accessibility via a communication network such as the Internet, thus allowing the user to access the digital camera from virtually an unlimited number of locations and with the camera in virtually any location.

Morris, 23: 67 – 24: 9.

Although it is not clear whether Examiner considers the client computer system or the server computer system as corresponding to “the host device” of claim 1, Morris fails to disclose or suggest **“based on said determined communication information, establishing a communication session between the digital camera device and the particular host device,”** as recited in claim 1. On the contrary, in Morris, there is no need for the digital camera to determine communication information, because, in Morris, *it is an executable program residing on server computer system that implements and manages the connection between the server computer system, the client computer system, and the digital camera.* (Morris, 7: 19-24.)

Because not every element of claim 1 is disclosed in Tullis, Nakagiri, and Morris, whether considered separately or in combination, claim 1 and its dependent claims are patentable in view of Tullis, Nakagiri, and Morris.

Claim 21 recites in part “based on said determined communication information ... estabiishing a communication session between the portable device and the particular

host device,” and therefore claim 21 and its dependent claims are patentable in view of Tullis, Nakagiri, and Morris for at least the reasons articulated with respect to claim 1.

Examiner further added Steinberg, Ward, and Allen in rejecting claims dependent on claims 1 and 21 respectively.

Steinberg is directed at an apparatus to serve as an interface for enabling a user of a portable still and or video digital camera to send image data directly from the camera to a communication network for transmission and downloading to a remote network location or remote computer (Steinberg, 1: 43-48). Ward is directed at a network configuration file for automatically transmitting images from an electronic still camera (Ward, title). Allen is directed at an electronic imaging system capable of image capture, local wireless transmission and voice recognition (Allen, title). None of these references remedies the shortcomings of Tullis in view of Nakagiri and further in view of Morris, as discussed above with respect to claims 1 and 21. Therefore claims dependent on claims 1 and 21 respectively are not obvious over the references cited.

Examiner rejected claims 41, 43-45, 51, 59, and 62 under 35 U.S.C. §103(a) as being unpatentable over Endsley, in view of Nakagiri, further in view of Morris.

As noted correctly by Examiner, Endsley fails to teach “a communication module for establishing a communication session between the portable device and the particular host device.” Thus, Endsley also fails to teach “a communication module for establishing, **based on said determined communication information**, a communication session between the portable device and the particular host device,” as recited by claim 41 as amended. As discussed above, neither Nakagiri nor Morris, whether considered individually or in combination, disclose this element. Further, as

also discussed above with respect to claims dependent on claims 1 and 21 respectively, additional references (i.e., Steinberg, Ward, and Allen) also fail to disclose this limitation. Examiner rejected claim 60 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of Inoue. Inoue is directed at reception method and apparatus for searching various first and second source devices adapted to send data signals to analog and optical input terminals (Inoue, title) and fails to disclose or suggest the above limitation.

Therefore, claim 41 and its dependent claims are not obvious over the references cited.

### **3. Conclusion**


Applicant respectfully submits that in view of the amendments and discussion set forth herein, the applicable rejections have been overcome. Accordingly, the present and amended claims should be found to be in condition for allowance.

If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Elena Dreszer at (408) 947-8200.

If there are any additional charges/credits, please charge/credit our deposit account no. 02-2666.

Respectfully submitted,  
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